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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,648	03/20/2002	Shinichi Takeshima	112342	2766

7590

03/17/2005

Oliff & Berridge
PO Box 19928
Alexandria, VA 22320

EXAMINER

JOHNSON, CHRISTINA ANN

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/088,648

Applicant(s)

TAKESHIMA ET AL.

Examiner

Christina Johnson

Art Unit

1725

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2, 7 and 8.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 10/6/04
13. ☒ Other: See Continuation Sheet.


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3/15/05

Continuation of 5. Applicant's reply has overcome the following rejection(s): Rejection under 35 USC 102(b) over EP 1004 347; rejection under 37 USC 102(b) over EP 1 008 378; Rejection under 35 USC 102(b) over Suzuki et al.; Rejection under 35 USC 103(a) over EP 0 852 966 alone.

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons set forth on the record in the final office action. Applicant argues that EP '966 does not disclose that the catalyst is capable of dealing with particulate matter. However, this goes to the intended use of the composition. Because the combined teachings of the reference teach or suggest all of the claimed structural limitations, the composition taught by the prior art references is considered to be capable of performing the intended use. Applicant further argues that there is no motivation to combine the references. This argument has been considered but is not persuasive. The primary reference teaches a composition comprising Rh, zirconia, and a zeolite hydrocarbon adsorbent. The secondary reference teaches the use of zeolite hydrocarbon adsorbent having a silica to alumina molar ratio greater than 40. Such a zeolite would be acidic - one cannot separate a property from a composition, as applicant is attempting to do. Applicant has not responded to the proposed modification, i.e. the substitution of a known, zeolite hydrocarbon adsorbent such as suggested by the reference. Applicant has further misrepresented the examiner - Applicant has stated that the "examiner has alleged that EP '966's first powder is an NO oxidation catalyst." However, the office action states that the first powder is considered to correspond to the NO oxidation catalyst, i.e. structurally, not functionally. Applicant is attempting to use the intended function of the composition to distinguish over the prior art, which is not proper. Applicant has failed to demonstrate that the combined teachings of the prior art would not result in the structure and composition claimed and therefore the rejection is maintained.

Continuation of 13. Other: For purposes of appeal, upon entry of the amendment, claims 1, 2, 7, and 8 stand rejected under 35 USC 103(a) over EP 0 852 966 in view of EP 1 004 347. This is the sole remaining rejection.


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3/15/05